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Paper No. 8

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JUL 23 2002

OFFICE OF PETITIONS

In re Application of
Scotto, et al.
Application No. 09/938,328
Filed: August 23, 2001
Attorney Docket Number: 426882000600

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition filed on April 26, 2002 under 37 CFR §1.47(a).

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on August 23, 2001, without an executed oath or declaration. Accordingly, on September 26, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an the basic filing fee, executed oath or declaration and a \$65.00 surcharge for its late filing.

In response, on April 26, 2002, applicant filed a \$65.00 surcharge, a partially executed oath, basic filing fee and to make the petition timely a five month request for extension of time.

A grantable petition under 37 CFR §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and, (4) a statement of the last known address of the non-signing inventor.

Applicant lacks item (1) as set forth above. Rule 47 applicant states inventor Boyer can not be located. Rule 47 applicant provided a statement of facts that indicates assignment and declaration papers were mailed to inventor Boyer, which were returned because inventor Boyer no longer resides at the last known address. A phone call was made to inventor Boyer's last known number but the phone number was no longer in service and no forwarding information was provided.

However, rule 47 applicant has failed to provide sufficient facts that would prove diligent efforts were made to locate inventor Boyer. Additional efforts need to be demonstrated to illustrate diligent effort. Did inventor Boyer's personnel file contain an

emergency contact number? Did rule 47 applicant attempt to call the emergency contact for forwarding information? Did rule 47 applicant contact former colleagues to determine if they had a forwarding address for inventor Boyer? Did rule 47 applicant do an electronic search for inventor Boyer?

Upon renewed petition, rule 47 applicant may wish to state any additional actions that have been taken in an attempt to locate inventor Boyer to establish diligent effort was used to locate inventor Boyer.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA 22202

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

B. M. Flanagan

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